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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/537,240      | 05/09/2006  | Danny Leonard Adcock |                     | 8509             |

7590 04/30/2008  
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| EXAMINER |
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LEWIN, ALLANA

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3764

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| MAIL DATE | DELIVERY MODE |
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04/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/537,240 | <b>Applicant(s)</b><br>ADCOCK ET AL. |  |
|                              | <b>Examiner</b><br>ALLANA LEWIN      | <b>Art Unit</b><br>3764              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because they are replete with errors, including missing reference numerals, as well as inconsistencies between that which is disclosed and referenced in the specification and the element referenced in the drawings. For example, a threaded cap is referenced in the specification with numeral 15, however this does not appear in the drawings; reference numeral 21 is disclosed as a resilient pad in the specification but does not reference a resilient pad in Figure 1. These are just two examples of the many errors and inconsistencies present in the drawings. Applicant is advised to carefully review all of the drawings and make all necessary corrections.

Additionally, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the many elements that are recited in the claims but not shown in the drawings (the internally threaded sleeve mating with an external threaded end portion of the inner tubular member, the outwardly projecting collar, etc.) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: the specification is replete with errors, such as missing letters (examples including, but not limited to, page 10, line 1 and page 11, lines 1-2) and blank spaces between words (an example including, but not limited to, page 11, lines 19 and 21).

Additionally, Applicant is advised that correction of the drawings in order to overcome the objections set forth above requires amendment to the specification in order for the corrected drawings to be consistent with the disclosure.

Appropriate correction is required.

### ***Claim Objections***

Applicant is advised that should claim 1 be found allowable, claims 9 and 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Also, should claim 2 be found allowable, claim 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Additionally, claims 3, 19 and 26 are objected to because of the following informalities: regarding claim 3, in line 4 the recitation 'tubular members' should presumably be --tubular elements-- in order to be consistent with the preceding claim language; regarding claim 19, in line 4, 'th' should presumably be --the--; regarding claim 26, the preamble concludes with a semicolon instead of a colon, and the method begins with step (e) and recites steps (e)-(h) rather than beginning with step (a) and reciting steps (a)-(d). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the upper arm exercise device disclosed by

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Applicant and recited in claims 2-8, 10-18 and 20-25, does not reasonably provide enablement for the multitude of devices for exercising the upper arm as recited in claims 1, 9 and 19. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Examiner notes that simply grasping a handheld object, i.e. a writing implement, a remote control, a utensil, etc., and orienting the arm at a 90 degree angle and then moving the forearm towards the upper arm would comprehend the language recited in claims 1, 9 and 19, since the handheld object comprehends the “device” and a “resistance force” is provided by the weight of the object and the user’s body in addition to air resistance. More specifically, performing a bicep curl with a dumbbell in one hand meets the language recited in claims 1, 9 and 19, with the dumbbell comprehending the “device” and the weight on the dumbbell providing a “resistance force.” These are just two examples of the ways in which claims 1, 9 and 19 are comprehended, and neither are enabled by Applicant's disclosure. Therefore, these claims are not commensurate in scope with that which is described or disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "said varying spring

rates" in lines 1-2, however springs with varying spring rates have not been positively recited in claim 5 or any preceding claim. Claim 4 provides a functional recitation of the 'end cap adapted to allow for the insertion...of compression springs of varying spring rates' which merely requires the capability of inserting such springs, but there is no positive recitation of these springs. Therefore, there is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9-17, 19-21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US Pat. No. 5,501,646).

Regarding claims 1, 9 and 19, the Miller device is fully capable of performing the function recited. Claim 1, 9 and 19 provide no structure and are merely a functional recitation of the intended use of Applicant's invention. Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claims 2 and 10, Miller discloses telescopically assembled inner and outer tubular elements (54, 70) provided with closure means; the outer tubular element provided with an 'inwardly projecting collar' on account of a flange (71) that projects inwardly (note Figure 7) to engage a circumferential groove (51) on the inner tubular element, with the shoulder formed by the groove (51) comprehending an 'outwardly projecting collar', with the engagement of the 'collars' preventing withdrawal of the inner tubular element from the outer tubular element with the tubular elements are telescopically assembled.

Regarding claim 3, Miller further discloses a compression spring (50) that provides an extending force when installed within the telescopically assembled tubular elements, with the ends of the spring acting against closure means and the extending force urging the tubular elements into a maximum extended position, and the extended position being limited by contact between the 'collars'.

Regarding claim 4, the end closure means of the outer tubular member comprises an end cap (55) including a threaded sleeve section (note Figure 7) that is adapted to mate with a threaded portion at the outward end of the tubular element; the end cap allowing for insertion of compression springs of varying spring rates into the tubular members, since removal of the end cap permits disassembly of the device thereby enabling this function.

Regarding claim 11, the closure means at the outward end of the outer tubular member is provided with a piston rod (18) that extends from the end closure means



substantially the length of the outer tubular member and ending in a piston (52) that is adapted for sliding sealing movement in the inner tubular member (note Figure 7).

Regarding claim 12, the end closure means of the outer tubular member comprises an end cap (55) including a threaded sleeve section (note Figure 7) that is adapted to mate with a threaded portion at the outward end of the tubular element; the end cap adapted to provide length adjustment via screwing or unscrewing the cap along its threaded engagement.

Regarding claim 13, a compression spring (50) is installed between the cap and the inwardly projecting collar of the inner tubular member; the spring providing an outward urging force biased to return the tubular members to a fully extended position.

Regarding claims 14 and 15, Miller discloses air bleed passageways (64) on the outward end of the inner tubular member, and teaches that alternative designs such as a valve can be utilized in order to vary the ratio of force on the insertion and return strokes (column 5, lines 40-45).

Regarding claim 16, as broadly recited and as best understood, Miller teaches 'closure means' provided with resilient pads on account of the chin cup being provided with a soft inner surface (44) such as a foam rubber material (column 4, lines 13-16) and the handle (20) made of rubber material (column 4, lines 10-12).

Regarding claim 17, one of the 'closure means' is provided with strapping means (22) *adapted to* secure the device to the user's wrist, as the strap is adjustable via a buckle (42) and can be looped about the user's wrist and is therefore capable of performing this function. Examiner notes that as broadly recited, the 'closure means'

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are taken to encompass the various elements on the outside and ends of the device. Additionally, the language 'adapted to secure the device to the wrist of a user' is functional language reciting the intended use. As noted above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 20, the device comprises a tubular member containing a compression spring (50) that acts on a piston (52) and piston rod (18) coaxial with the tubular members so as to urge the piston and piston rod into a maximum extended position.

Regarding claim 21, the length of the compression spring is adjustable in order to vary the compressive force exerted by the spring on the piston and piston rod (column 5, lines 24-29); the installed length being the length of the spring when the piston and piston rod are in a maximum extended position.

Regarding claim 25, the rotational movement is restricted between a first angle  $\alpha$  and a second angle equal to or less than  $\alpha/2$ , as the device inherently restricts movement from a larger angle to a smaller angle due to its size, construction and function.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (US Pat. No. 6,245,034).

Bennett discloses an exercise device for the arms that provides a resistance force to the rotational movement of the forearm towards the upper arm along the line between the shoulder and the wrist, and teaches adjusting the device so that when in a relaxed state the device restricts the angle at the elbow to about 90 degrees (note Figure 4), as well as adjusting the device so that different resistance forces are applied via adjustment of a compression spring (column 3, lines 45-67 to column 4 lines 1-24). Therefore, the recited method is inherent to the Bennett device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 18, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller alone.

Regarding claim 5, Miller does not specifically disclose varying spring rates in the ranges of 11-15 lb/in and 17-21 lb/in. However, Miller does teach adjusting the resistance provided by the spring and therefore a range of spring rates are permitted with the device. It would appear that the rates recited by Applicant are capable of being performed with the Miller device. Additionally, absent criticality of the specified values and ranges, the capability of the Miller device appears to be appropriate and achieve similar results.

Regarding claim 18, Miller is silent with respect to the overall length of the device. However, the range recited by Applicant would appear to comprehend Miller's device. To any extent that it is felt that overall length of the device does not comprehend the claimed range, it would have been obvious to an artisan of ordinary skill at the time of invention to have made the overall length of the device in the range of 130 to 180mm in order for the device to be appropriately and suitably sized for its use.

Regarding claim 22, Miller teaches the use of a chin cup (28), which, absent further limitation and as broadly recited, comprehends Applicant's 'shoulder yoke' since Applicant has failed to recite any structure that would distinguish the chin cup from a 'shoulder yoke'. Additionally, the chin cup can be abutted against the user's shoulder during use, and is therefore 'adapted to support said device at the shoulder of the user'. Miller also provides a strap (22), which absent further limitation and as broadly recited, comprehends Applicant's 'wrist yoke' since Applicant has failed to recite any structure that would distinguish the chin cup from a 'wrist yoke'. With respect to the positioning of these elements, the chin cup/shoulder yoke is provided at the outer end of the piston rod, while the strap/wrist yoke is provided at the tubular member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have changed the position of these elements and provided the chin cup/shoulder yoke at the tubular member and the strap/wrist yoke at the outer end of the piston rod, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in art. Furthermore, changing the position of these elements would not change or hinder use of the device.

Regarding claims 23, Miller does not teach adjustment of the chin cup/shoulder yoke; however it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). Thus, it would have been obvious to an artisan of ordinary skill at the time of invention to have made the chin cup/shoulder yoke adjustable in order to make the device suitable for users of varying sizes.

Regarding claim 25, the 'wrist yoke' is provided with strapping means (22) adapted to secure the 'yoke' to a user's wrist as it is capable of such, since adjustment of the strapping means is provided by a buckle (42) and since the strap can be looped around the user's wrist.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the list of references cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLANA LEWIN whose telephone number is (571)272-5560. The examiner can normally be reached on Monday-Friday, 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on 571-272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. L./

Examiner, Art Unit 3764

April 25, 2008

/LoAn H. Thanh/

Supervisory Patent Examiner, Art Unit 3764